

REMARKS

This amendment is submitted with a request for a one month extension and appropriate fees in reply to the Office Action dated October 10, 2007. Claims 1-15 currently stand rejected. Applicant has amended independent claims 1 and 10 to more clearly recite the claimed invention. New claims 16-18 have been added to further define patentable aspects of the claimed invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicant respectfully requests reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §112

Claims 1 and 10 currently stand rejected under 35 U.S.C. §112, first paragraph, as lacking enablement. Specifically, the Office Action asserts that the “security feature composed of a prepaid account, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure.” Applicant respectfully notes that this statement, which appears to be an invocation of the rule that a critical feature not claimed should be rejected under 35 U.S.C. §112 as described in MPEP 2184.08(c), does not make sense. MPEP 2184.08(c) provides that any “feature which is taught as critical in a specification and is not recited in the claims should result in the rejection of such claim under the enablement provision of 35 U.S.C. 112.” However, if the security feature of a prepaid account is not even enabled by the disclosure, it would not seem to be possible for such feature to be considered critical. In this regard, that which is not even described could not be considered as critical or essential to the practice of the invention. Accordingly, Applicant assumes that the Office Action instead meant to assert that a prepaid account security feature is disclosed as being critical or essential to the practice of the invention, but is not claimed.

Regardless of what was intended by the above quoted statement of the Office Action, Applicant respectfully submits that “a prepaid account” is not critical to the practice of the invention. Most illustrative of this fact is undoubtedly the lack of any requirement in the specification regarding prepaid accounts. In this regard, although a user account is described, such account is not specified as being, and need not be, a prepaid account. The present

application describes (e.g., at lines 5-11 of page 2 of the specification as filed) that, according to “a first aspect of the invention”, payment for the downloadable content is handled by transfer of an amount from an account upon approval from the user. As such, the disclosure above is merely an aspect of an exemplary embodiment and not necessarily the only or critical way that embodiments of the present invention may be accomplished. Furthermore, as stated above, this account is not specified as being a prepaid account in any case. The paragraphs extending from line 4 to line 26 of page 6 of the specification further describe that required information for affecting a purchase is stored on the SIM card of the phone after a subscription agreement has been entered. Accordingly, when the user requests available items from which to select content for potential download, the user’s account status is verified as being valid before providing a list of available items. The status and/or validity of the account is not indicated as being associated with a prepaid balance, nor is such an association required impliedly or inherently. Indeed, the user account could be based on available credit, a prepaid balance, or any other account status agreed to between the user and the service provider. Moreover, this section also clearly states that the description corresponds to an embodiment (albeit a preferred embodiment), but does not limit all embodiments to having such an account. Rather, the embodiments described merely enable the handling of payment for content without further user interaction, or automatic payment handling. Whether such payment handling occurs by transferring funds from a prepaid account, a credit based account (e.g., line of credit or credit card) or other mechanism is not specified and therefore not disclosed as being critical.

As a reminder, the requirement of the MPEP citing the patent laws is that a “feature which is taught as critical in a specification and is not recited in the claims should result in the rejection of such claim under the enablement provision of 35 U.S.C. 112.” Exemplary features of certain embodiments, even if they are exemplary features of a preferred embodiment, do not rise to the level of being taught as being critical. Accordingly, Applicant respectfully asserts that a security feature composed of a prepaid account is not critical to the claimed invention and respectfully requests that, if such rejection is to be maintained, any subsequent rejections should detail what disclosure of the present application is relied upon as indicating that such feature is disclosed at all, much less disclosed as being critical.

Accordingly, a prepaid account is not critical and not required to be claimed in the claims of the present application and the rejections of claims 1 and 10 as lacking enablement are respectfully traversed.

Claim Rejections - 35 USC §103

Claims 1-15 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wisner et al. (U.S. Patent No. 6,868,403, hereinafter “Wisner”) in view of Sasaki et al (U.S. Patent Application Publication No. 2002/0077988, hereinafter “Sasaki”).

Independent claims 1 and 10 have been amended to clarify that handling of payment for enabling storing of pre-studied downloadable content for a software application is accomplished without further user interaction beyond selecting the pre-studied downloadable content for storage. In other words, merely in response to selection of the pre-studied content for storage, payment for the same content that was requested and pre-studied is handled automatically. As such, the election to save the content triggers payment for the content without further user interaction.

As described above and at page 6 of the present application, according to an exemplary embodiment, during a subscription agreement, the user may provide information that may be used to set up a secure session with content providers and an account service. The information may be stored in a SIM of the user’s terminal and retrieved for session set up. The user’s account status and validity are verified and a list of items from which the user can select are provided. As further described at page 7 of the present application, when the user selects to save a downloaded and previewed item, the session is seamlessly handled without further user interaction to draw payment from the user account and enable storing of the previewed item.

Sasaki does not provide details regarding how payment transactions are conducted. Thus, Sasaki fails to teach or suggest the above recited feature and is not cited as such. However, Wisner explains its payment structure in some detail. In this regard, the user may provide a credit card or debit card for use in payment (col. 11, lines 12-15). During registration for the service, the user may provide credit card information and the credit card’s validity may be verified (col. 13, lines 30-36). If the credit card is authorized, the user may receive a “passport” (col. 13, lines

38-40), which is stored at the client computer for enabling the user to purchase and preview music (col. 14, lines 19-20). However, when the user elects to purchase music, the user must separately complete a form at operation 910 of FIG. 9 as described at col. 16, lines 52-55. As such, payment according to Wiser is not handled in the seamless manner provided by embodiments of the claimed invention.

To the contrary, Wiser provides information regarding what may be considered the setup of an account during the registration process that results in issuance of the passport. However, the passport does not enable seamless download and purchase of content items. Instead, the passport merely at best enables seamless downloading of content items, whereas the subsequent purchase of any content items requires further user interaction to complete. In this regard, even if the user's credit card, which was supplied initially and verified before issuance of the passport, is valid, the user still needs to complete the form at operation 910 to complete the transaction. This further interaction with the user stands in stark contrast to the claimed invention in which handling of payment for enabling storing of pre-studied downloadable content for a software application is accomplished without further user interaction beyond selecting the pre-studied downloadable content for storage. Thus, Wiser also fails to teach or suggest that handling of payment for enabling storing of pre-studied downloadable content for a software application is accomplished without further user interaction beyond selecting the pre-studied downloadable content for storage as provided in independent claims 1 and 10.

Since neither Sasaki nor Wiser teaches or suggests the above described features of independent claims 1 and 10, any combination of Sasaki and Wiser also fails to teach or suggest the above described features. Claims 2-9 and 11-15 depend either directly or indirectly from independent claims 1 and 10, respectively, and thus include all the recitations of their respective independent claims. Thus, dependent claims 2-9 and 11-15 are patentable for at least the same reasons given above for independent claims 1 and 10.

Accordingly, for all the reasons stated above, Applicant respectfully submits that the rejections of claims 1-15 are overcome.

Appl. No.: 10/084,982
Amdt. Dated 02/08/2008
Reply to Office Action of 10/10/2007

Newly Added Claims

Applicants have added new claims 16-18 to more particularly define aspects of the present application. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claims are in condition for allowance.

Appl. No.: 10/084,982
Amdt. Dated 02/08/2008
Reply to Office Action of 10/10/2007

CONCLUSION

In view of the amendments and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



Chad L. Thorson
Registration No. 55,675

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON FEBRUARY 8, 2008.
LEGAL02/30689481v1